



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/892,767 | 06/28/2001 | Moshe Weiner | Q63327 | 3418 |

7590 04/13/2004
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3213

| EXAMINER | |
|--------------------|--------------|
| FLETCHER, MARLON T | |
| ART UNIT | PAPER NUMBER |
| 2837 | |

DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/892,767

Applicant(s)

WEINER ET AL.

Examiner

Marlon T Fletcher

Art Unit

2837

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-42 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

This application is no longer subject to appeal. This is a non-final office action.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-13, 15, 18, 20-25, 27, 30, 31, and 33-39, are rejected under 35 U.S.C. 103(a) as being unpatentable over Catona (6,288,319) in view of Landante et al. (5,555,017).

As recited in claims 1, 20 and 25, Catona discloses a tele-karaoke system for performing karaoke comprising: a tele-karaoke server (18) storing a plurality of songs in karaoke format; a user interface (12) allowing a user to select a song in karaoke format from said tele-karaoke server in order to perform the song as a karaoke performance; and a user multimedia server (20) recording the karaoke performance as a message (figure 3).

As recited in claims 2, 8, 13, 21, 24, 30, 34, and 36, Catona discloses the tele-karaoke system, wherein the user multimedia server allows the user to send the recorded performance as a message to another as discussed in column 3, lines 42-45.

As recited in claims 3, 9, 22, and 37, Catona discloses the tele-karaoke system, wherein the user multimedia server allows the user to edit the recorded karaoke performance as discussed in column 2, lines 47-49 and column 3, lines 7-20.

As recited in claims 4, 10, 31, and 38, Catona discloses the tele-karaoke system, wherein the user multimedia server allows the user to listen to the recorded karaoke performance as discussed in column 3, lines 1-2.

As recited in claims 5, 11, 23, 33, 35, and 39, Catona discloses the tele-karaoke system, wherein the user multimedia server allows the user to store the recorded karaoke performance via storage (20).

As recited in claims 6 and 12, Catona discloses the tele-karaoke system, wherein said user multimedia server includes customer storage space to store recorded performances of the user via storage (20).

As recited in claim 7, Catona discloses the tele-karaoke system, further comprising a tele-karaoke service provider coupled to the user interface and the tele-karaoke server to regulate user interaction and retrieve songs from the tele-karaoke server as seen in figure 2.

As recited in claims 15, 18, and 27, Catona discloses the tele-karaoke system, wherein the user interface is a personal computer (12).

Catona does not disclose a MMS server.

However, Landante et al. provides a communication network, wherein a user controls multimedia data through a network, wherein the signals include audio, video, and data, wherein the network utilizes a MMS (abstract; figures 1, 2, and 5).

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the teachings of Landante et al. with the apparatus of Catona, because the combination allows the communication to expand from multimedia to MMS messaging, wherein the transmission of video, audio, and text can be transmitted over the network.

4. Claims 14, 16, 19, 20, 26, 28, 29, are rejected under 35 U.S.C. 103(a) as being unpatentable over Catona in view Landante et al. as applied to claims 1-13, 15, 18, 20-25, 27, 30, 31, and 33-39 above, and further in view of Lewis (5,564,001).

Catona and Landante et al. are discussed above. Catona does not disclose a telephone as the interface to the system.

However, as discussed in claim 14, 20 and 29, Landante et al. disclose a multimedia system, wherein the user interface may be a telephone (column 8, lines 14-33).

Lewis discloses a user interface is a cellular telephone as discussed in the abstract.

As recited in claims 16, 19, 26, and 28, Lewis discloses the system, wherein the user interface is a fixed telephone as seen in figure 2A.

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the teachings of Lewis with the apparatus of Catona in view of Landante et al., because Lewis provides an alternate interface for use of the multimedia system.

5. Claims 17, 32, and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Catona in view of Landante et al. as applied to claims 1-13, 15, 18, 20-25, 27, 30, 31, and 33-39, above, and further in view of Liu.

Catona is discussed above. Catona does not disclose editing text and video.

However, as recited in claims 17, 32, and 40-42 Liu discloses a tele-karaoke system, wherein the user edits the recorded message by adding at least one of text (102) and video (96).

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the teachings of Liu with the apparatus of Catona in view of Landante et al., because Liu provides the addition of video and text editing to provide the lyrics for the user.

Response to Arguments

6. Applicant's arguments with respect to claims 1-42 have been considered but are moot in view of the new ground(s) of rejection.

The applicant argues that Catona fails to disclose MMS server that records a karaoke performance. The examiner agrees that the server is not a MMS server. A karaoke performance is merely a performance of a sing-along, wherein a pre-recorded song is played and a person sings along with the pre-recorded song. Catona provides this element and further discloses recording this performance as seen in figure 3, wherein the recording can be stored in a server or database. Landante et al. are


Art Unit: 2837

provided to show the use of a MMS multimedia messaging server in the same environment, wherein it would be obvious to combine Landante et al. with Catona.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marlon T Fletcher whose telephone number is 703-308-0848. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Nappi can be reached on 703-308-3370. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



Marlon T Fletcher
Primary Examiner
Art Unit 2837

MTF
April 5, 2004